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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,694	12/08/2003	Paul R.M. Carpentier	HYPRP001	5713
22434	7590	10/24/2006	EXAMINER	
BEYER WEAVER & THOMAS, LLP			LIE, ANGELA M	
P.O. BOX 70250			ART UNIT	
OAKLAND, CA 94612-0250			PAPER NUMBER	
			2163	

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/730,694	CARPENTIER ET AL.	
	Examiner	Art Unit	
	Angela M. Lie	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 12-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/7/04, 11/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed October 2, 2006 have been fully considered but they are not persuasive.
2. With respect to the applicant's assertion on pages 2 and 3, alleging that the examiner should examine all the groups because there is no serious burden, the examiner disagrees. How does the applicant define serious burden? As long the searches for all the groups cannot be conducted at the same time, i.e. searching for the same invention, it creates a serious burden because each of groups would have to be searched separately placing emphasis on different limitations and structure, which in fact would require a search among different sets of prior art.
3. Furthermore, the examiner would like to note that all of the species correspond to different figures in the instant specification, clearly showing distinctions between the inventions.
4. Moreover the examiner would also like to emphasize that there should be only one invention in one patent application.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 5 is rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: what happens if the second computer file is not a later version of the first computer file, but completely independent file?
8. The term "may" in claim 5 is a relative term, which renders the claim indefinite. The term "may" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. From the language of claim 5, it is unclear if the user uses the third message to navigate through the content space, or not. Since the applicant states that the "user may use the third message", it leads to the conclusion that the third message is not essential to the claimed invention.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claim 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hussam (US Publication 2003/0050927).**

As to claim 5, Hussam discloses a method of enabling forward navigation, wherein the method comprises: receiving a first message digest (Figure 9, Outline) that identifies a first computer file (Figure 9, document A); receiving a second message digest (Figure 9, Outlines) that identifies a second computer file (Figure 9, document B); receiving an indication that the second computer file is a later version of the computer file (date of creation would be this indication, paragraphs 83 and 10); creating a mapping table that maps the first message digest into the second message digest (Figure 9, wherein all if the message digests come to the common point, i.e. map first and second message digests); creating a descriptor file (Figure 9, Tabular report) that includes the first message digest and an identification of the mapping table (summary of experts' highlights); and creating a third message digest of the descriptor file and returning the third message digest to a user (Figure 18, user inputs annotations), whereby the user uses the third message digest to navigate forward through the content space formed by the first and the second computer files (Figure 20).

As to claim 6, Hussam discloses a method wherein the first message digest (Figure 9, Outline) is the digest of first descriptor file (wherein a first descriptor file is considered to be a Highlighted HTML document with a user annotations or highlights, paragraphs 216, 213 and 199) that identifies first computer file (Figure 9, element HTML document Highlighted by Expert A), wherein the second message digest (Figure 9, Outline) is the digest of a second descriptor file (wherein a second descriptor file is considered to be a Highlighted HTML document with a user annotations or highlights,

paragraphs 216, 213 and 199) that identifies the second computer file (Figure 9, HTML document highlighted by Expert B).

As to claim 7, Hussam discloses a method wherein the first and second descriptor files include metadata concerning the first and second computer files, respectively (the first and second descriptor files, as indicated above, presents both Experts' highlights and user annotations (paragraphs 216, 213 and 199), therefore those additional information regarding the documents are considered metadata (i.e. data about the data)).

As to claim 8, Hussam discloses a method wherein the second computer file is received by the user or is created by the user (Figure 18, i.e. retrieving).

As to claim 9, Hussam discloses a method wherein the descriptor file includes meta data (as shown in figure 9, tabular report includes the highlights which are considered metadata).

As to claim 10, Hussam discloses a method wherein the descriptor file includes the mapping table (Figure 9, descriptor file has include mapping information because all the highlights have to refer to its original source document).

As to claim 11, Hussam discloses a method wherein the descriptor file includes a message digest that identifies the mapping table (Figure 9, the descriptor file (tabular report) comprises the message digest information (Outline of experts' highlights)).

The Prior Art

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Hung et al (US Publication 2004/0107214)** disclose a customized document portfolio system integrating IP libraries and technology documents, wherein the corresponding versions of a document are synchronized for easier search.
- **Brelín et al (US Patent 6810446)** disclose a system and method for navigating and deleting descriptors, wherein descriptors are related with respect to each other in hierarchical structure.

Inquiry

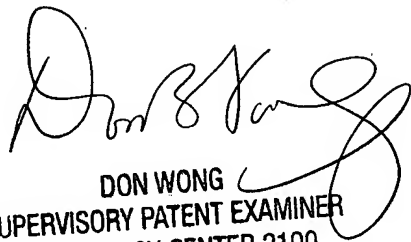
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela M. Lie whose telephone number is 571-272-8445. The examiner can normally be reached on M-F.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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